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In re Application of
MUELLER et al.
U.S. Application No. 10/527,212
PCT No.: PCT/EP03/09981
Int. Filing Date: 09 September 2003
Priority Date: 18 September 2002
Attorney Docket No.: C 2341 PCT/US
For: BOREHOLE TREATMENT AGENT
CONTAINING LOW-TOXIC OIL PHASE

DECISION ON REQUEST

This decision is issued in response to applicants' "Response to Decision on Request for Correction of Inventorship" filed 27 February 2007, which is being treated as a Renewed Request under 37 CFR 1.497(d).

BACKGROUND

On 09 September 2003, applicants filed international application no. PCT/EP03/09981 which claimed a priority date of 18 September 2002. The international application named Heinz Mueller as applicant/inventor. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 18 March 2005.

On 10 March 2005, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; a copy of the international application; and a preliminary amendment.

On 28 September 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 28 November 2005, applicants filed a declaration executed by: Heinz Mueller, Nadja Herzog; and Stephan Von Tapazicza.

On 10 March 2006, the United States Designated/Elected Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating that the declaration filed 28 November 2005 was defective because it indicated additional inventors not listed on

the published international application.

On 31 March 2006, applicants filed a "Request for Correction of Inventorship." In a decision dated 22 December 2006, applicants' request under 37 CFR 1.497(d) was dismissed without prejudice.

On 27 February 2007, applicants filed the present "Response to Decision on Request for Correction of Inventorship."

DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Nadja Herzog and Stephan Von Tapazicza to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17; and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
- (4) any new oath or declaration required by paragraph (f) of this subsection.

Applicants have satisfied items (1); (2); (3) and (4).

CONCLUSION

The request under 37 CFR 1.497(d) is GRANTED.

A review of the application papers reveals that applicants have completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be

given an international application filing date of 09 September 2003 and a date of 28 November 2005 under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

A handwritten signature in black ink, appearing to read "Anthony Smith".

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